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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,241

01/19/2006

Walter Kuhn

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12/01/2010

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EXAMINER

GRESO, AARON J

ART UNIT

PAPER NUMBER

1763

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/565,241	Applicant(s) KUHN ET AL.	
	Examiner AARON GRESO	Art Unit 1763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-11 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9-11 and 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Any rejections and/or objections made in the previous Office Action and not repeated below, are hereby withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

New grounds of rejection set forth below are necessitated by Applicant's amendment filed on 13 September 2010.

Applicant has amended Claim 1 to limit the mixture basis to a mixture requiring no more than 20% wt% of a trans cyclohexyl ester and at least 80% wt% of a cis cyclohexyl ester {underlined indicating amendment}, along with further indicating that the amounts be based on a total mass of the mixture.

"A total mass of the mixture" being taken as a mixture of the amount of 3,3,5-trimethylcyclohexyl ester present.

Claim Rejections - 35 USC § 103(a)

Claims 1, 2, 7, 9-11, 13-18 are rejected under 35 U.S.C. 103(a) as being obvious over Eliel et al. (Journal of Organic Chemistry 1970, Vol 35 (8) pp 2716-2722).

As to Claims 1 and 7:

Eliel et al. discloses making cis 3,3,5-trimethylcyclohexyl acetate (p 2722 1st full paragraph) in an amount of 89% {addressing Claims 1 and 7}. The process would be expected to add cis material to a composition as it reacts from cis 3,3,5-trimethylcyclohexanol precursor {further addressing Claim 7}.

The reference does not disclose the employment of cis-3,3,5-trimethylcyclohexyl propionate.

On the other hand, in regard to Figure 1 below: Claims 7, 9-18 are rejected under 35 U.S.C. 103 as obvious in accord with MPEP 2144.09 regarding Homology and Isomerism which states:

“Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties”.

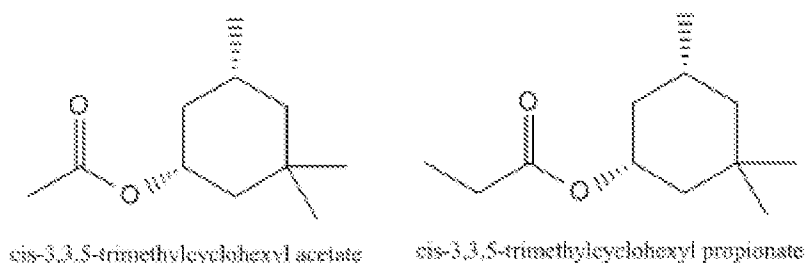


Figure 1. Structures of cis-3,3,5-trimethylcyclohexyl acetate and propionate—per Chimera Ultra 12.0.

It would have been obvious to employ cis-3,3,5-trimethylcyclohexyl propionate in the same manner as taught by Eliel et al., as a similar homolog of cis-3,3,5-trimethylcyclohexyl acetate, for employed for the same or similar application with the same or similar results with a reasonable expectation of success.

Further as to Claim 2:

As no trans 3,3,5-trimethylcyclohexyl amount is indicated, the amount is taken as zero and the mixture, based on a total mass of the mixture of cis and trans, 3,3,5-trimethylcyclohexyl esters, would be expected to have at least twice as much cis than trans 3,3,5-trimethylcyclohexyl ester material.

Further as to Claims 9-11, 13-18:

The properties or scent of the material in the final composition is added during synthesis, {taken as the reference is intent to make the material, with its properties}, the fragrance of the material would be expected to be inherent as Case law holds that a material and its properties are inseparable. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

The reference does not disclose the employment of cis-3,3,5-trimethylcyclohexyl propionate.

On the other hand, in regard to Figure 1 above: Claims 9-18 are also rejected under 35 U.S.C. 103 as obvious in accord with MPEP 2144.09 regarding Homology and Isomerism which states:

“Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties”.

It would have been obvious to employ cis-3,3,5-trimethylcyclohexyl propionate in the same manner as taught by Eliel et al., as a similar homolog of cis-3,3,5-trimethylcyclohexyl acetate, for employed for the same or similar application with the same or similar results with a reasonable expectation of success.

Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102 (b) as being anticipated by Behura et al. (Current Science Vol 83 no 11 pp. 1312-1313, 2002) as evidenced by Chowdhury et al. Bangladesh J. Sci. Ind. Res. 43 (2) pp 259-266 2008).

As to Claim 1:

The reference indicates that the essential oil of *Curcuma longa*, acquired from the Rhizome of *C. longa*, is employed for curing pimples and for the whitening of skin and is also indicated to exhibit a camphor odor (col 1 paragraphs 1 and 2 page 1312).

As compositions of the oil material are known in the art to inherently comprise cis 3,3,5-trimethylcyclohexyl acetate {see informational reference: Chowdhury et al. Bangladesh J. Sci. Ind. Res. 43 (2) pp 259-266 2008, Table II, page 264 and page 259 col 1, 1st paragraph, the amount of the acetate indicated as being 0.55% as determined by a mass spectrometer (page 260-261 bridging paragraph)}; the material is taken to have been used or known in the art more than one year prior to the Applicants' filing, and that Behura et al. disclose that the composition inherently comprises 0.55% {taken as mass} of a cis 3,3,5-trimethylcyclohexyl acetate.

When 0.55% is taken as the amount of the 3,3,5-trimethylcyclohexyl ester material present because Behura et al. {as evidenced by Chowdhury et al.} does not indicate whether the material comprises a trans component or not, the material is taken to, at most, comprise a trans component of 3,3,5-trimethyl cyclohexyl acetate less than the corresponding cis chemical; including the amount of zero trans 3,3,5-trimethyl cyclohexyl acetate.

The reference discloses or inherently discloses a mixture composition with a cis 3,3,5-trimethyl cyclohexyl acetate amount, as analyzed by a mass basis, being 100%; the amount of trans material taken and 0% as analyzed by mass basis; the weight basis being taken as inherent as a mass is analyzed; a mass basis being required by the limitations of Claim 1.

The composition is silent as to the percentage of cis and trans material based upon a total mass of the mixture.

On the other hand, as Behura et al. does not indicate whether the material comprises a trans component or not., the material is taken to comprise a trans component of 3,3,5-trimethyl cyclohexyl acetate less than the corresponding cis chemical; including the amount of zero.

Further, when the amount of a material is 100 percent, the amount would inherently be 100% by weight, or moles or volume.

The reference, as evidenced, discloses the limitation of the applicable Claim.

Further as to Claim 2:

As the reference does not disclose the amount of a Claimed trans material, a trans material is not taken to be present in an amount that is measured; that amount being less than 0.005 percent {an amount that would be expected to be rounded up to 0.01 percent}; only 2 significant digits past the zero being reported by Behura et al. However, as the amount of trans material, per instant Claim 1, is not indicated to be required to more than zero, and when the amount of trans material is zero, the amount of the cis material is at least twice as high as the trans material.

As to Claim 4:

As the material is indicated to be comprise 1,8-cineole as a 28 percent component (Behura et al. Table 1 page 1312), and as 1,8-comeole is indicated to make odors fresher {see informational reference: 1,8-cineole, The Good Scents Company

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page 3}, it would be expected that the composition disclosed would make materials, it is added to, comprise a fresher enabling substance than without the material for, example, a composition for treating whiteness of skin, when compared to a skin treatment composition that does not comprise the mixture and otherwise not comprising the ester containing oil composition.

As to Claim 5:

The oil composition, disclosed by Behura et al., as evidenced by Chowdhury et al., comprises at least one other fragrance substance (Table 1 page 1312).

The reference, as evidenced, discloses the limitation of the applicable Claims.

Response to Arguments

Applicant's arguments filed 13 September 2010 have been fully considered.

Applicant's arguments with respect to claims 7 and 9-18 {page 5} have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

Applicant's arguments with respect to Claims 1-2 and 4-5 have been considered but are not persuasive.

Applicant argues {pages 6-7}:

That the reference of Behura as evidenced by Chowdhury et al. does not disclose the presence of at least one trimethyl cyclohexyl trans material.

In response, addressing the Claims as written: Claim 1-2 and 4-5 do not require the presence of a trans material. The Claims allow for the lower limit of the trans material to be zero in "a total mass of the mixture".

The address by the Examiner of 22 July 2010, is towards a composition is applied to a material that is not required to be in the composition. Accordingly, no evidence is provided in the case for when the amount of the trans material is allowed to be present in the amount of zero. The rejections provided by the Examiner in regard to the Claims 1-2, 4-5 trans amounts are taken as being commiserate with the scope of the Claim limitations.

The rejections stand.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action while the same grounds or rejection are also applied.

Examiner Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON GRESO whose telephone number is (571)270-7337. The examiner can normally be reached on M-F 0730-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571 272 1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron J. Greson/

/Milton I. Cano/

Supervisory Patent Examiner, Art Unit 1763

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